

REMARKS

The undersigned, on behalf of the Applicants, thank the Examiner for withdrawing previous rejections on record. Applicants respectfully request entry of the present amendment, the consideration of the following remarks and withdrawal of the pending rejection. Claims 158-164, 166-202, 205-207, 215 and 216 are pending in the application. Claim 158, 187, 205, 215 and 216 have been amended to eliminate the size limitation of the patch. No new matter has been added.

I. THE PRESENT CLAIMS ENJOY THE PRIORITY OF MARCH 17, 2000.

In the OA, the Examiner's sole reason for denying the priority of March 17, 2000 is that the priority Korean Application 2000/0013636 ("priority document '636") did not describe the contact area width as provided in the previously submitted claims. *See* OA at p. 2, 2nd ¶. Applicants respectfully states that Examiner's allegation is incorrect.

The test for establishing priority is whether the corresponding foreign application clearly allow those of ordinary skill in the art to recognize that the present inventors invented what is claimed at the time of filing the priority document '636. *See In re Grosselli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989). Those of ordinary skill would have recognized that the priority document '636 provides sufficient support at its page five (5), the second paragraph. Accordingly, the size, shape and width measurements of the patch are to be ascertained in a manner to ensure flexibility of the patch from person to person. Moreover, the preferred "patch is thin enough so that it may not disturb user's speech or other social activities of their lives." [Emphasis Added]. Applicants respectfully state that such disclosure adequately support patch sizes to the extent that those of ordinary skill would have understood the patches of the present invention were in possession of the inventors at the time of filing of the priority document '636.

Nevertheless, for purposes of expediting the prosecution, Applicants have amended the claims to remove the size, shape and width limitation of the claimed product. In the OA, the Examiner has already determined that all presently claimed limitations are adequately supported in the priority application. Therefore, Applicants respectfully request the Examiner to recognize Applicants' right to claim the benefit for the priority date of March 17, 2000.

II. US PATENT 6,458,380 TO LEADERMAN IS NOT A COMPETENT PRIOR ART.

Applicants respectfully disagree with the Examiners reliance on Leaderman as a competent prior art. The Examiner's sole rationale on employing Leaderman was on the basis that the previously presented claims did not enjoy the priority date of March 17, 2000, allegedly because the priority document '636 did not support the contact area width limitations of said claims. *See* OA at p. 2, 2nd ¶. The Examiner then offers Leaderman for reasons other than meeting the size and the contact area width limitation. Such reliance on Leaderman by itself is in conflict with the Examiner's rationale for denying the priority claim.

Assuming *arguendo* that the Examiner's rationale for denying the benefit of earlier priority date is proper, only those species of the claimed products that are directed to the claimed contact area width would have not enjoyed such benefit. The Examiner may not deny the benefit for the entire concept of combining polyvinyl pyrrolidone and hydrogen peroxide in an adhesive layer of a tooth whitening patch. In the OA, the Examiner relied on Leaderman for its teaching of polyvinyl pyrrolidone and hydrogen peroxide use in a wound dressing product. *Id.* at p. 3. However, Leaderman can not be used for the purposes introduced by the Examiner, because such concept of combining polyvinyl pyrrolidone and hydrogen peroxide in a tooth whitening patch

was first disclosed by the Applicants in priority document '636 regardless of the size and contact width limitations.

Nevertheless, Applicants have removed the contact width limitation at issue to expedite issuance of a favorable decision. Without discussing the scientific flaws of this rejection, Applicants respectfully resubmit that the full scope of the pending claims are supported in the priority document '638 and thus Leaderman is not a competent prior art. For such reasons alone, any prior art rejection relying on the teachings of Leaderman should be withdrawn.

Leaderman's publication date is October, 1, 2002 which is after the earliest priority date of the present application. Therefore, Leaderman can only be available as a prior art under 35 U.S.C. §102 (e). Leaderman earliest priority date is November 9, 2000. The present invention, on the other hand, enjoys the benefit to the filing date of the priority document '636 which is March 17, 2000. Therefore, Leaderman can not be used against the instant claims.

Applicants provide herewith another copy of the certified English copy of the priority Korean Patent Applications 2000/0013636 filed on March 17, 2000, previously submitted in November 2006. Applicants draw the Examiner's attention to the abstract, pages 4-5, and the claims of the priority document '636. The disclosure clearly conveys to those of ordinary skill in the art that present inventors were the first to invent teeth whitening delivery systems having an adhesive layer comprising the combination of at least a peroxide such as hydrogen peroxide and a film former glassy polymer such as polyvinyl pyrrolidone. Thus, the present claims can enjoy the priority date of March 17, 2000 and for such reasons Leaderman is not a competent prior art.

III. REJECTIONS OF CLAIMS OVER LEADERMAN IN VIEW OF GALLOPO US 2001/0002252 AND SAGEL US PATENT 5,891,453 OR LEADERMAN IN VIEW OF GALLOPO US 2001/0002252, TAPOLSKY US PATENT 6,159,498 AND SEGAL US PATENT 5,891,453 ARE IMPROPER AND SHOULD BE WITHDRAWN, BECAUSE LEADERMAN IS NOT A COMPETENT PRIOR ART.

The rejections as set forth in the Office Action employ the combination of the teachings of Leaderman, Gallopo, Tapolsky and Sagel. Yet, the Examiner essentially relies on Leaderman as the primary reference to argue that the combination of hydrogen peroxide, polyvinyl pyrrolidone and hydroxypropyl methylcellulose has been described in delivery systems containing teeth whitening agents. *See* OA at pp. 2-6. Aside from the fallacy in the scientific reasoning of such rejection as discussed in prior responses, Applicants respectfully reiterate that Leaderman can not be used against the instant claims for the concept proposed by the Examiner, because such concept was first disclosed by the present inventors.

Accordingly, Applicants respectfully submit that they are entitled to the benefit of a priority that predates the effective filing date of Leaderman reference. Thus, any prior art rejection relying on Leaderman is deemed improper and should be withdrawn.

None of the secondary references, Gallopo, Tapolsky, and Segal alone or in combination meet all the elements of the present claims. Thus, any prior art rejection relying on the their combination of teachings would also be improper.

CONCLUSION

Applicants respectfully request that the pending claims are allowable. If a telephone conference would be of assistance in advancing the prosecution of the present application, Applicants' undersigned attorney invites the Examiner to telephone at the number provided.

Applicant also authorizes the charge of any deficiency and/or the credit of any overpayment to Deposit Account No. 50-1943.

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Respectfully submitted,

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